



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,489	10/16/2003	Jeffrey M. Linnen	GP140-04.UT	3927

21365 7590 12/16/2004
GEN PROBE INCORPORATED
10210 GENETIC CENTER DRIVE
SAN DIEGO, CA 92121

EXAMINER

LUCAS, ZACHARIAH

ART UNIT	PAPER NUMBER
----------	--------------

1648

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,489

Applicant(s)

LINNEN ET AL.

Examiner

Zachariah Lucas

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-82 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17, drawn to probes for detecting a nucleic acid in a sample comprising fragments of SEQ ID NO: 101, classified in class 536, subclass 24.32.
 - II. Claims 18-30, drawn to primer pairs for amplification of a nucleic acid that may be in a sample, the first primer being a fragment of SEQ ID NO: 73, and the second being a fragment of SEQ ID NO: 59, classified in class 536, subclass 24.33.
 - III. Claims 31-44, drawn to probes for detecting a nucleic acid in a sample comprising fragments of SEQ ID NO: 99, classified in class 536, subclass 24.32.
 - IV. Claims 45-54, drawn to primer pairs for amplification of a nucleic acid that may be in a sample, the first primer being a fragment of SEQ ID NO: 52, and the second being a fragment of SEQ ID NO: 41, classified in class 536, subclass 24.33.
 - V. Claims 55-67, drawn to probes for detecting a nucleic acid in a sample comprising fragments of SEQ ID NO: 95, classified in class 536, subclass 24.32.
 - VI. Claims 68-82, drawn to primer pairs for amplification of a nucleic acid that may be in a sample, the first primer being a fragment of SEQ ID NO: 16, and the second being a fragment of SEQ ID NO: 1, classified in class 536, subclass 24.33.

Art Unit: 1648

The inventions are distinct, each from the other because of the following reasons:

2. The inventions of Group I-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions each relate to probes or primers for different sequences within the West Nile Virus genome. Because it is not clear if the identified probes match with the indicated primers, these sequences, and because each has a different sequence, thus hybridizes to a different viral sequence (thereby having a different mode of operation), the various inventions are distinct. Because each of the primers, and each of the probes are directed to different sequences, each of the probes is distinct from the other probes, and each primer pair is distinct from the other primers. The inventions are therefore distinct one from another.

Species Election

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

For Group I, if the Applicant elects this Group for examination, the Applicant is required to elect one of the fragments of SEQ ID NO: 101 identified in claims 6, 16, or 17 as filed.

For Group II, if the Applicant elects this Group for examination, the Applicant is required to elect one of the fragments of SEQ ID NO: 73, identified in claim 26 as filed, and one of the fragments of SEQ ID NO: 59, also identified in claim 26 as filed.

For Group III, if the Applicant elects this Group for examination, the Applicant is required to elect one of the fragments of SEQ ID NO: 99 identified in claims 43 or 44 as filed.

Art Unit: 1648

For Group IV, if the Applicant elects this Group for examination, the Applicant is required to elect one of the fragments of SEQ ID NO: 52, identified in claim 51 as filed, and one of the fragments of SEQ ID NO: 41, also identified in claim 51 as filed.

For Group V, if the Applicant elects this Group for examination, the Applicant is required to elect one of the fragments of SEQ ID NO: 95 identified in claims 66 or 67 as filed.

For Group VI, if the Applicant elects this Group for examination, the Applicant is required to elect one of the fragments of SEQ ID NO: 16, identified in claim 78 as filed, and one of the fragments of SEQ ID NO: 1, identified in claims 79 and 80 as filed.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, the first claim of the respective Group of inventions is generic to the species within that Group.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Art Unit: 1648

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

4. Because these inventions are distinct for the reasons given above, have acquired a separate status in art because of recognized divergent subject matter and different classifications, and because the literature and sequence searches required for any one of the groups is not required for the others, restriction for examination purposes as indicated is proper.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 571-272-0905. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm.

Art Unit: 1648

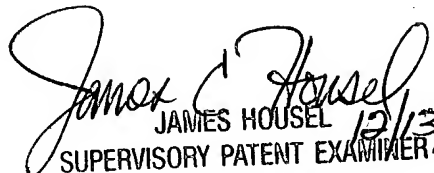
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Z. Lucas

Patent Examiner



JAMES HOUSEL 12/13/04
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600